

Applicant 61545 JPW

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APR 25 2002

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
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Washington, D.C. 20231

TECH CENTER 1600/2900

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/769,902	01/25/2001	Goodman et al.	61545/JPW/RAD

3/25/2002  
30 Days: 4/24/2002  
2 mos: 5/24/2002  
3 mos: 6/24/2002  
4 mos: 7/24/2002  
5 mos: 8/24/2002  
Please find below a communication from the EXAMINER in charge of this application  
6 mos: 9/24/2002 smv

MAR 28 2002

EXAMINER	
Sita S. Pappu	
ART UNIT	PAPER NUMBER
1636	6

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. §§ 1.821-1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Applicant must comply with the requirements of the sequence rules (37 CFR 1.821-1.825) before the application can be examined under 35 U.S.C. §§ 131 and 132.

Sequences are disclosed in the specification but are not identified by their sequence identifiers (i.e. SEQ ID NO). For example, specification on page 9 discloses nucleotide sequences that are not identified by sequence identifiers. Applicant is further reminded that amendment to the specification, and/or claims is required to comply with 37 C.F.R. 1.821(d). Each sequence disclosed in the specification and/or figures must be identified by its sequence identifier (i.e., SEQ ID NO:). Applicant is reminded that the entire specification and figures should be reviewed for sequence disclosures.

An initial copy of CRF, a paper copy of the sequence listing and a statement that the paper copy and the computer readable copy are the same and include no new matter are required.

APPLICANT IS GIVEN 30 days FROM THE DATE OF THIS LETTER WITHIN WHICH TO COMPLY WITH THE SEQUENCE RULES, 37 C.F.R. §§ 1.821-1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 C.F.R. § 1.821(g). Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 C.F.R. § 1.136. In no case may an applicant extend the period for response beyond the six month statutory period. Direct the response to the undersigned. Applicant is requested to return a copy of the attached Notice to Comply with the response.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Sita S. Pappu whose telephone number is (703) 305-5039. If the examiner cannot be reached, inquiries can be directed to Supervisory Patent Examiner Irem Yucel whose telephone number is (703) 305-1998. The fax number for the organization where this application is assigned is (703) 308-8724. Any inquiry of a general nature or relating to the status of this application should be directed to the Patent Analyst at (703) 305-2982.

*Anne-Marie Baker*

ANNE-MARIE BAKER  
PATENT EXAMINER

Applicant: Reba Goodman et al.  
U.S. Serial No.: 09/769,902  
Filed: January 25, 2001  
Exhibit A

# NOTICE TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES

Applicant must file the items indicated below within the time period set the Office action to which the Notice is attached to avoid abandonment under 35 U.S.C. § 133 (extensions of time may be obtained under the provisions of 37 CFR 1.136(a)).

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 C.F.R. 1.821 - 1.825 for the following reason(s):

- ☒ 1. This application clearly fails to comply with the requirements of 37 C.F.R. 1.821-1.825. Applicant's attention is directed to the final rulemaking notice published at 55 FR 18230 (May 1, 1990), and 1114 OG 29 (May 15, 1990). If the effective filing date is on or after July 1, 1998, see the final rulemaking notice published at 63 FR 29620 (June 1, 1998) and 1211 OG 82 (June 23, 1998).
- ☒ 2. This application does not contain, as a separate part of the disclosure on paper copy, a "Sequence Listing" as required by 37 C.F.R. 1.821(c).
- ☒ 3. A copy of the "Sequence Listing" in computer readable form has not been submitted as required by 37 C.F.R. 1.821(e).
- ☐ 4. A copy of the "Sequence Listing" in computer readable form has been submitted. However, the content of the computer readable form does not comply with the requirements of 37 C.F.R. 1.822 and/or 1.823, as indicated on the attached copy of the marked -up "Raw Sequence Listing."
- ☐ 5. The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A Substitute computer readable form must be submitted as required by 37 C.F.R. 1.825(d).
- ☐ 6. The paper copy of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 C.F.R. 1.821(e).
- ☒ 7. Other: Sequences are disclosed in the specification but are not identified by their sequence identifiers (i.e. SEQ ID NO). Applicant is further reminded that amendment to the specification is required to comply with 37 C.F.R. 1.821(d). Each sequence disclosed in the specification must be identified by its sequence identifier (i.e., SEQ ID NO:). Applicant is reminded that the entire specification should be reviewed for sequence disclosures.

## Applicant Must Provide:

- ☒ An initial or substitute computer readable form (CRF) copy of the "Sequence Listing".
- ☒ An initial or substitute paper copy of the "Sequence Listing", as well as an amendment directing its entry in the specification.
- ☒ A statement that the content of the paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 C.F.R. 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d).

For questions regarding compliance to these requirements, please contact:

For Rules Interpretation, call (703) 308-4216

For CRF Submission Help, call (703) 308-4212

PatentIn Software Program Support

Technical Assistance.....703-287-0200

To Purchase PatentIn Software.....703-306-2600

**PLEASE RETURN A COPY OF THIS NOTICE WITH YOUR REPLY**

**PLEASE USE THE CHECKER VERSION 3.1 PROGRAM TO REDUCE ERRORS.  
SEE BELOW FOR ADDRESS:**

**<http://www.uspto.gov/web/offices/pac/checker>**

→ Applicants submitting genetic sequence information electronically on diskette or CD-Rom should be aware that there is a possibility that the disk/CD-Rom may have been affected by treatment given to all incoming mail. Please consider using alternate methods of submission for the disk/CD-Rom or replacement disk/CD-Rom. Any reply including a sequence listing in electronic form should NOT be sent to the 20231 zip code address for the United States Patent and Trademark Office, and instead should be sent via the following to the indicated addresses:

1. EFS-Bio (<<http://www.uspto.gov/ebc/efs/downloads/documents.htm>> , EFS Submission User Manual - ePAVE)
2. U.S. Postal Service: U.S. Patent and Trademark Office, Box Sequence, P.O. Box 2327, Arlington, VA 22202
3. Hand Carry directly to:  
U.S. Patent and Trademark Office, Technology Center 1600, Reception Area, 7<sup>th</sup> Floor, Examiner Name, Sequence Information, Crystal Mall One, 1911 South Clark Street, Arlington, VA 22202  
Or  
U.S. Patent and Trademark Office, Box Sequence, Customer Window, Lobby, Room 1B03, Crystal Plaza Two, 2011 South Clark Place, Arlington, VA 22202
4. Federal Express, United Parcel Service , or other delivery service to: U.S. Patent and Trademark Office, Box Sequence, Room 1B03-Mailroom, Crystal Plaza Two, 2011 South Clark Place, Arlington, VA 22202

Revised 01/29/2002

<b>Interview Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/769,902	GOODMAN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sita S Pappu	1636	

All participants (applicant, applicant's representative, PTO personnel):

(1) Sita S Pappu. (3)\_\_\_\_\_.

(2) Peter Phillips. (4)\_\_\_\_\_.

Date of Interview: 12 March 2002.

Type: a) ☒ Telephonic b) ☐ Video Conference  
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.  
If Yes, brief description: \_\_\_\_\_.

Claim(s) discussed: 1-12.

Identification of prior art discussed: N/A.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

i) ☒ It is not necessary for applicant to provide a separate record of the substance of the interview (if box is checked).

Unless the paragraph above has been checked, THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

*Anne-Marie Baker*

**ANNE-MARIE BAKER  
PATENT EXAMINER**

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

\_\_\_\_\_  
Examiner's signature, if required

## Summary of Record of Interview Requirements

### Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

#### Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

##### Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

#### 37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,  
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

#### Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Called Attorney of record to verify the status of the amendment to the specification cancelling all reference to Drawings and/or Figures as required by the Office of Petitions (Paper # 4, 07/27/2001) when the filing date of 01/25/2001 was granted on the petition filed by the Applicant. Paper #4 required the amendment to be made prior to any Office Action on the merits and this was not yet complied by the Applicant. Attorney Peter Phillips was notified of this during this telephonic Interview and the Attorney communicated that an amendment will be filed shortly. Also notified the Attorney that a Notice to Comply with sequence Rules is being mailed meanwhile by the Examiner..



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,902	01/25/2001	Reba Goodman	61545/JPW/RAD	5006

7590

03/25/2002

John P. White  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, NY 10036

EXAMINER

PAPPU, SITA S

ART UNIT PAPER NUMBER

1636

DATE MAILED: 03/25/2002

6

Please find below and/or attached an Office communication concerning this application or proceeding.



61545.ST25

RECEIVED

APR 25 2002

TECH CENTER 1600/2900

SEQUENCE LISTING

<110> Rebe Goodman, Hana Lin, and Martin Blank  
<120> A METHOD FOR REGULATING GENES WITH ELECTROMAGNETIC RESPONSE ELEMENTS  
<130> 0575/61545/JPW/PJP/PL  
<140> 09/769,902  
<141> 2001-01-25  
<160> 2  
<170> PatentIn version 3.1  
<210> 1  
<211> 29  
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<213> artificial sequence  
<220>  
<223> primer incorporating restriction site  
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cctgagctct tctttgatca gaatcgata 29  
  
<210> 2  
<211> 27  
<212> DNA  
<213> artificial sequence  
<220>  
<223> primer incorporating restriction site  
<400> 2  
tctaagcttc ttgatcaga atcgatg 27



**Marked-up Version of Amendments**

Additions to the specification are indicated by double underlining.

**In the Specification:**

The replacement paragraph beginning on page 9, line 9:

**--Construction of EMRE-CAT expression vector**

Fig. 1A illustrates construction of the EMRE-CAT expression vector (pΔ11+ 900bp + CAT). Plasmid pΔ11-CAT was digested with Hind III and PVU II, harvested from gel. Two oligonucleotides were used for PCR which allowed us to create two enzyme sites and amplify the 900bp region from c-myc promoter.

1. CCTGAGCTCTTCTTTGATCAGAATCGATA (SEQ ID NO: 1)
2. TCTAAGCTTCTTTGATCAGAATCGATG (SEQ ID NO: 2)

1 μl of plasmid (digested with Hinde III and PVUII) was mixed with 3 μl PCR product, placed at 12°C overnight for ligation and transformed using DH52 bacteria. Clone hybridization verified insert.--

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Reba Goodman, et al  
Serial No.: 09/769,902 Examiner: S. Pappu  
Filed: January 25, 2001 Group Art Unit: 1636  
For: A METHOD FOR REGULATING GENES WITH  
ELECTROMAGNETIC RESPONSE ELEMENTS

1185 Ave of the Americas  
New York, New York 10036  
April 18, 2002

U.S. Patent & Trademark Office  
Box Sequence P.O. Box 2327  
Arlington, VA 22202

SIR:

**STATEMENT IN ACCORDANCE WITH 37 C.F.R. §1.821(f)  
FOR ABOVE-IDENTIFIED APPLICATION**

In accordance with 37 C.F.R. §1.821(f), I hereby certify that the computer readable form containing the nucleic acid and/or amino acid sequences required by 37 C.F.R. §1.821(e) and submitted in connection with the above-identified application, has the same information as the paper copy of the Sequence Listing attached hereto as **Exhibit B** (page 1-1).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,



Paul Lim  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
(212) 278-0400

Applicant: Reba Goodman et al.  
U.S. Serial No.: 09/769,902  
Filed: January 25, 2001  
**Exhibit D**